

ESTTA Tracking number: **ESTTA482192**

Filing date: **07/09/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sher-Wood Hockey Inc.
Granted to Date of previous extension	07/11/2012
Address	2745 Sherwood Street Sherbrooke, QC J1K1E1 CANADA
Attorney information	Paul Fields Leason Ellis LLP One Barker Avenue - Fifth Floor White Plains, NY 10601 UNITED STATES tmdocket@leasonellis.com, fields@leasonellis.com, segall@leasonellis.com

Applicant Information

Application No	85442066	Publication date	03/13/2012
Opposition Filing Date	07/09/2012	Opposition Period Ends	07/11/2012
Applicant	Bauer Hockey, Inc. 100 Domain Drive Exeter, NH 03833 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Hockey equipment and accessories, namely, hockey helmets; face masks for hockey helmets; protective face-shields for hockey helmets; hockey goalie masks
Class 028. First Use: 2007/03/21 First Use In Commerce: 2007/03/21 All goods and services in the class are opposed, namely: Hockey equipment, namely, ice hockey goalie equipment, namely, pads, catcher gloves, blocker gloves (based on use); hockey equipment, namely, skates, sticks, gloves, protective gear, pants; ice hockey goalie equipment, namely, skates, sticks, pants, chest and arm protective gear; hockey equipment accessories, namely, athletic supports, athletic support cups, garter belts, wrist guards, neck guards, neck protectors, pucks, mouth guards, skate lace hooks, blade guards (based on intent to use)

Grounds for Opposition

Other	lack of bona fide intent
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Attachments	NEXUS-NotOpp.pdf (6 pages)(105707 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/paulfields/
Name	Paul Fields
Date	07/09/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SHER-WOOD HOCKEY INC.)	
)	
Opposer,)	
)	Opposition No. _____
v.)	Application Ser. No. 85442066
)	Published in the Official Gazette on
BAUER HOCKEY, INC.)	March 13, 2012
)	Filing Date: October 7, 2011
Applicant.)	

NOTICE OF OPPOSITION

Sher-Wood Hockey Inc. ("Opposer"), a corporation organized under the laws of Canada located at 2745 Sherwood Street, Sherbrooke (Quebec), Canada J1K1E1, believes it will be damaged by the registration of the designation NEXUS, as shown in Application Serial No. 85442066 (the " '066 Application") for use in connection with "Hockey equipment and accessories, namely, hockey helmets; face masks for hockey helmets; protective face-shields for hockey helmets; hockey goalie masks; Hockey equipment, namely, ice hockey goalie equipment, namely, pads, catcher gloves, blocker gloves (based on use); hockey equipment, namely, skates, sticks, gloves, protective gear, pants; ice hockey goalie equipment, namely, skates, sticks, pants, chest and arm protective gear; hockey equipment accessories, namely, athletic supports, athletic support cups, garter belts, wrist guards, neck guards, neck protectors, pucks, mouth guards, skate lace hooks, blade guards", filed by Bauer Hockey, Inc. ("Applicant") and hereby opposes the same. An extension of time to oppose the '066 Application has been granted until July 11, 2012 on behalf of Opposer.

The grounds for opposition are:

1. Opposer is the owner of the mark NEXON for use with a variety of hockey related equipment.

2. Opposer has applied under U.S. Serial No. 85498741 (the “ ‘741 Application”) to register its NEXON mark for use with:

Hockey equipment and accessories namely face masks for hockey helmets, protective face-shields for hockey helmets, visors for hockey helmets. Lacrosse equipment, namely face masks for helmets, visors for helmets, protective face-shields for helmets in Class 9;

Hockey equipment and accessories, namely duffel bags, sport bags; Lacrosse equipment, namely duffel bags, sport bags in Class 18;

Hockey equipment and accessories, namely pants, uniforms, gloves, garter belts, jerseys, socks. Lacrosse equipment, namely pants, gloves, garter belts, uniforms, jerseys, socks, lacrosse shoes, lacrosse boots, shorts in Class 25; and

Ice hockey sticks. Hockey equipment and accessories, namely ankle guards, arm pad, athletic support cups, athletic supporters, balls, blade for hockey sticks, guards, body pads, butt ends for hockey sticks, chest protectors, chin protectors, elbow pads, goaltender trappers, helmets, hip pad girdles, knee pads for athletic use, leg guards, masks, mouth guards, neck guards, neck protectors, nets, pads, protective cups, pucks, pucks, shin guards, shoulder pads for athletic use, skate lace hooks, skates, sport bags, throat protectors, whistles, wrist guards. Lacrosse equipment, namely, abdominal pads, ankle guards, arm pad, athletic support cups, athletic supporters, balls, balls, body pads, butt ends for lacrosse sticks, chest protectors, chin protectors, elbow pads, guards, handles for lacrosse sticks, helmets, hip pad girdles, knee pads for athletic use, lacrosse heads, lacrosse sticks, leg guards, masks, mouth guards, neck guards, neck protectors, nets, pads, pockets for lacrosse sticks, protective cups, protective sports clothing designed to protect against sports injuries, shafts for lacrosse sticks, shin guards, shoulder pads for athletic use, sticks, strings for lacrosse pockets, throat protectors, whistles, wrist guards, wrist pads in Class 28.

3. In an Office Action dated April 4, 2012, Opposer’s ‘741 Application was preliminarily refused based on Applicant’s prior-pending ‘066 Application.

4. Opposer and a related company of Applicant are parties to an ongoing dispute in Canada related to their respective NEXON and NEXUS marks.

5. On October 7, 2011, Applicant filed the ‘066 Application seeking registration of the NEXUS mark and vaguely defining the goods as: “hockey equipment and accessories” in Class 28 (the “Original Identification”).

6. As filed, the '066 Application alleged that the NEXUS mark had been used in commerce at least as early as March 21, 2007 in connection with all of the goods in the Original Identification.

7. Opposer's '741 Application was filed on December 19, 2011.

8. On January 27, 2012, Opposer *sua sponte* filed a preliminary amendment (the "Preliminary Amendment") in connection with the '066 Application, which amendment amended the identification of goods and the basis therefor to the following:

Class 28 (based on use): Hockey equipment, namely, ice hockey goalie equipment, namely, pads, catcher gloves, blocker gloves (hereinafter the "Use-Based Goods")

Class 9 (based on intent to use): Hockey equipment and accessories, namely, hockey helmets; face masks for hockey helmets; protective face-shields for hockey helmets; hockey goalie masks

Class 28 (based on intent to use): hockey equipment, namely, skates, sticks, gloves, protective gear, pants; ice hockey goalie equipment, namely, skates, sticks, pants, chest and arm protective gear; hockey equipment accessories, namely, athletic supports, athletic support cups, garter belts, wrist guards, neck guards, neck protectors, pucks, mouth guards, skate lace hooks, blade guards

9. The Preliminary Amendment was filed without a supporting declaration as to Applicant's intent to use, with Applicant's attorney indicating her belief that a supporting declaration was not required.

10. The Examining Attorney did not require a declaration as to Applicant's bona fide intent to use.

11. Applicant never submitted a declaration as to its bona fide intent to use the NEXON mark in connection with the goods in the Preliminary Amendment as to which actual use was not claimed, i.e., the goods except for the Use-Based Goods (hereinafter the "Expanded Goods").

12. Upon information and belief, Applicant did not have a bona fide intent to use the NEXON mark in connection with the Expanded Goods when it filed the '066 Application.

13. Upon information and belief, Applicant did not have a bona fide intent to use the NEXON mark in connection with the Expanded Goods when it filed the Preliminary Amendment. The Preliminary Amendment was improper for failing to include a declaration as to Applicant's alleged bona fide intent.

14. By virtue of the Preliminary Amendment, Applicant impermissibly expanded its listing of goods to include those beyond which it had actually used the mark as alleged in the Original Identification.

15. The Preliminary Amendment thus allowed Applicant to obtain the benefit of a constructive first use date on the Expanded Goods, even though the Original Identification contemplated only goods for which the mark was currently in use at the time of filing.

16. Opposer is directly harmed by the Preliminary Amendment as the constructive filing date for the Expanded Goods is prior to Opposer's filing date of its '741 Application.

17. For these reasons, Opposer would be damaged by the registration of the '066 Application.

WHEREFORE, Opposer respectfully requests that the '066 Application be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Pursuant to 37 C.F.R. §2.101 Opposer has served a copy of the Notice of Opposition on the

Applicant identified on the USPTO's TARR database by first class mail on July 9, 2012. A copy of the Certificate of Service is attached.

The required fee of \$600.00 is enclosed.

Respectfully submitted,

LEASON ELLIS LLP

Dated: White Plains, New York
July 9, 2012

By: /paulfields/
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Attorneys for Opposer
Sher-wood Hockey Inc.

CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail, postage pre-paid, upon Applicant's Counsel of Record at the following address:

Christie Baty Hudgins
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, District of Columbia 20001

Dated: July 9, 2012

_____/SergeyLysenko/
Sergey Lysenko